

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 14706-0002001
CERTIFICATE OF MAILING BY EFS-WEB FILING I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: <u>February 9, 2009</u> Date of Deposit <u>/Spencer C. Patterson/</u> Signature <u>Spencer C. Patterson</u> Typed or Printed Name of Person Signing Certificate	Application Number 10/726,284	Filed December 2, 2003
	First Named Inventor Robin Pou et al.	
	Art Unit 3685	Examiner John M. Winter
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>43,849</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: right;">_____ /Spencer C. Patterson/ Signature _____ Spencer C. Patterson Typed or printed name _____ (214) 747-5070 Telephone number _____ February 9, 2009 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>		
<input type="checkbox"/> Total of no. forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robin Pou et al. Art Unit : 3685
Serial No. : 10/726,284 Examiner : John M. Winter
Filed : December 2, 2003 Conf. No. : 5291
Title : DISTRIBUTION AND RIGHTS MANAGEMENT OF DIGITAL CONTENT

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS SUBMITTED WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Pre-Appeal Brief is responsive to the final Office Action mailed October 8, 2008 (“Final Action”) and the Advisory Action dated February 3, 2009 (“Advisory Action”). Claims 49-54, 60-62, 100-103, and 108-112 stand rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent No. 6,044,469 (“*Boebert*”) in view of U.S. Patent No. 6,226,618 (“*Downs*”) and further in view of U.S. Patent No. 4,740,890 (“*William*”).¹ Appellants respectfully disagree that the claims are obvious and assert that these rejections are improper.

I. Previous Office Actions Have Not Addressed the Specific Elements of the Currently Pending Independent Claims

Appellants submit that neither the Final Action nor the Advisory Action have addressed the arguments and claim amendments with regards to independent claims 49, 60, 100, and 108 set forth in both Appellants' Amendment in Reply to Action of April 4, 2008 and Reply to Final Action of October 8, 2008. Specifically, the Advisory Action and Final Action have failed to differentiate between the elements of independent claims 49 and 60² and now-cancelled independent claim 1, stating instead that "Claims 49 [and] 60...are not patentably distinct from claim 1 and are rejected for at least the same reasons[.]" Office Action, p. 4. In previous responses, Appellants have explicitly noted that Claims 49 and 60 recite different claim elements than those recited in now-cancelled independent claim 1, and that the subsequent office actions

¹ Appellants note that claims 1-19 and 74-84 have been cancelled, while claims 20-48, 55-59, 63-73, 85-99, 104-107 and 113-118 have been previously withdrawn. These remarks only address pending claims 49-54, 60-62, 100-103 and 108-112.

² Independent claim 100 contains certain aspects analogous to claim 49, while independent claim 108 recites certain aspects analogous to claim 60.

have failed to offer any reasoning or support for the continued rejections of the other independent claims.³

Claim 1, at the time of its cancellation, recited the following:

1. A method for managing digital rights, the method comprising:
 - detecting a data file on a user device, wherein the data file includes a digital wrapper preventing access to the data file without a valid authorization;
 - determining whether the user device includes software for disabling the digital wrapper, with the determination being made using executable instructions associated with the digital wrapper;
 - searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user device;
 - identifying information relating to an authorization to access the data file;and
 - disabling the digital wrapper based on the authorization.

Claim 49 and Claim 60, however, recite elements that were never included in claim 1 and which have not been specifically rejected by any of the previous rejections, nor had any portions of the cited references identified as specifically teaching or suggesting the respective claim elements. For example, Claim 49 recites “detecting an attempt to transfer a data file between [a] user device and an external device,” that the “data file is stored in an unwrapped form prior to the attempt to transfer the data file,” and “applying a digital wrapper to the unwrapped data file in response to the detected attempt to transfer the data file.” Similarly, Claim 60 recites “identifying a media file stored on a user device for distribution to an external device, where the media file is stored in an unwrapped form prior to distribution” and “applying a digital wrapper to the media file before distribution occurs.” Each of these example elements are absent from now-cancelled independent claim 1.

Appellants submit that each and every element of the pending independent claims has not been adequately addressed in previous office actions.

³ Specifically, Appellants cancelled independent claim 1 in the Response to Final Action mailed December 22, 2008, leaving only independent claims 49, 60, 100, and 108 pending in the Present Application. Although the elements of the remaining independent claims differ from those of cancelled claim 1, no arguments or rejections addressing the remaining independent claims has been provided. For example, the Advisory Action's rejection of the pending claims merely states that “the Applicants argument fails to overcome the prior art rejection” without any explanation or rebuttal in response to Appellants' multiple arguments submitted in the Response to Final Action.

II. **Independent Claims 49, 60, 100 and 108 are Allowable Over the *Boebert-Downs-William* Combination**

While the previous actions have failed to provide any arguments or rejections addressing the specific elements of independent claims 49 and 100 unique from cancelled claim 1, Appellants submit that – regardless of the failure to provide justification for the previous rejections – *Boebert*, *Downs*, and *William*, either alone or in combination, fail to teach or suggest each and every element of the independent claims.

Generally, claim 49 is directed to the problem of preventing data files from being copied off of a user device to some external device where the data file is subject to unauthorized access, while still allowing the data file to remain freely accessible within a user device on which it resides for authorized use. Accordingly, when a transfer of a data file is attempted, the file is wrapped to prevent unauthorized access after the file is actually transferred. Thus, after the transfer, access to the file can be limited to authorized users and/or authorized devices by the applied digital wrapper. Neither *Boebert*, *Downs*, nor *William* teach or suggest storing a data file in an unwrapped form on a user device prior to an attempt to transfer the data file and applying a digital wrapper to the unwrapped data file in response to detecting an attempt to transfer the data file before allowing the attempted transfer as recited in claim 49.

Boebert, for example, is directed to a data communication system including a secure processing unit that communicates with a personal keying device and a crypto media controller attached to a user's computer. *See Boebert*, Abstract. Communication between elements of the system creates keys, identifiers, and attributes used to identify and authenticate the user, assign user security access rights and privileges, and assign media and device attributes to a data access device according to a predefined security policy. *Id.* *Boebert*, however, seems to at least teach away from storing a data file in an unwrapped form on a user device prior to an attempt to transfer the data file, instead teaching that access to files within a unit of media is allowed only “at the last possible moment” using a “combination of an ‘access vector’ assigned to an individual and the ‘device attributes’ assigned to a particular Workstation.” *Id.* at 3:20-24. In other words, *Boebert*'s media is stored in encrypted form before, during, and after any transfer. Thus, *Boebert* fails to teach or suggest that files are stored in an unwrapped form on a user

device, where a digital wrapper is applied to the file in response to detecting an attempt to transfer the data file.

Downs, on the other hand, discloses a system and related tools for the secure delivery and rights management of digital assets. *See Downs*, Abstract. However, *Downs* explicitly teaches away from the claim 49 elements of storing a data file in unwrapped form and in response to an attempt to transfer the data file, applying the digital wrapper, instead teaching the enforcement of content usage conditions as performed by the following steps:

“First, upon reception of the Content 113 copy...the End-User Device(s) 109 marks the Content 113 with a Copy/Play Code 523 representing the initial copy/play permission. Second, the Player Application 195 cryptographically scrambles the Content 113 before storing it in the End-User Device(s) 109. The Player Application 195 generates a scrambling key for each Content Item, and the key is encrypted and hidden in the End-User Device(s) 109. Then, every time the End-User Device(s) 109 accesses the Content 113 for copy or play, the End-User Device(s) 109 verifies the copy/play code before allowing the de-scrambling of the Content 113 and the execution of the play or copy.”

Downs, 21:43-63 (emphasis added). In direct contrast to claim 49, *Downs* describes that content is encrypted and stored (in an encrypted form) on the user device immediately upon receiving the content, requiring the content to be decrypted and verified before any access for copy or play on the user device.

Further, *William* discloses an apparatus for preparing and using software during a trial period associated with the software. *See William*, Abstract. *William* also teaches away from storing a data file in an unwrapped form on a user device prior to an attempt to transfer the data file and wrapping the file in response to a detected attempt to transfer the content, instead describing that whenever a new version of the trial software is created, that version is associated with a “usage count..., [a] lock condition as to whether [the software] is locked or unlocked...and the output code for the disk...” *Id.* at 3:39-43. As the trial software is run on a computer, the system determines whether the trial software is locked, and if it is not locked, whether the usage count, or predetermined number of available uses, is zero. *See id.* at 4:13-29. The usage count is decremented with each use of the trial software, until the usage count reaches zero, wherein the trial software is no longer executable without providing an unlock code associated with the particular version of the trial software received from a third party, such as the software manufacturer or distributor. *See id.* at 4:37-5:2. In other words, *William* teaches that the

trial software is received by the associated user or system in a protected format (that defines and enforces the trial period), and not that trial software is "stored in an unwrapped form prior to the attempt to transfer the [content]" and wrapped "in response to a detected attempt to transfer the [content]" as recited by claim 49. For at least these reasons, the *Boebert-Downs-William* combination fails to teach or suggest each and every element of claim 49.

Accordingly, Appellants respectfully request reconsideration and allowance of claim 49. Further, claims 60, 100, and 108 include certain aspects analogous to claim 49 and are allowable for at least the reasons discussed above.

CONCLUSION

For the reasons above, Appellants respectfully submit that the present claims are allowable over the cited prior art references. Reversal of the rejections under 35 U.S.C. §103(a) is respectfully requested. If questions remain, please contact the undersigned.

A Petition for One Month Extension of Time, Pre-Appeal Brief Request for Review and Notice of Appeal, along with any required fees for filing same, are being filed and submitted concurrently with these Remarks Submitted With Pre-Appeal Brief Request For Review. If any additional extension of time is required, Appellants hereby request the appropriate extension. The Examiner is hereby authorized to charge any required fees, or credit any overpayments to Deposit Account No. 06-1050, referencing the above attorney docket number.

Respectfully submitted,

Date: February 9, 2009

/Spencer C. Patterson/
Spencer C. Patterson
Reg. No. 43,849

PTO Customer No. 26231
Fish & Richardson P.C.
1717 Main Street, Suite 5000
Dallas, TX 75201
Telephone: (214) 747-5070
Facsimile: (877) 769-7945